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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/654,858
Filing Date: September 5, 2000
Appellant(s): ATLWIES, TONY,
 CHOCK, RAYMOND

Darien K. Wallace
Reg 53,736

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 8, 2008.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct

(4) Status of Amendments After Final.

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct

(5) Summary of the Invention.

The summary of the invention contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon.

20010011341	Hayes et al	08-2001
20020107809	Biddle et al	08-2002

(9) Grounds of Rejection.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Biddle et al (U.S. Patent Application Pub. No. 2002/0107809 A1).

3. As per claim 10, Biddle et al teach an improved system for software distribution (*improved distribution system, 20*) over wide area computer networks (*internet, 35*), the networks comprising a network conduit (*data links 45, 50 and 55*), at least one e-commerce server computer (*distributor 25, vendor 40*) in communication (*interconnected*) with the network conduit, at least one customer terminal computer (*user computer, 30*) in communication with the network conduit, and at least one supplier server computer (*distributor 25, vendor 40*) in communication (*interconnected*) with the network conduit, each the computer comprising at least one programmable computer comprising input means, display means, processing means, storage means and means for communicating with the network conduit (*see abstract figs 1, 2, page 2,*

paragraphs 0013, 0015, and 0016, page 4 paragraph 0049, 0050), the system comprising e-commerce site means (licensing server, 82) for distributing licensing modules (licensing) to each the customer terminal computer via the network conduit; and program download site means (distributor 25, vendor 40) for distributing program modules (software) to each the customer terminal computer via the network conduit (see fig 1, page 5, paragraph 0053, 0054, 0055).

4. As per claim 11, Biddle et al teach an improved system wherein the e-commerce site means comprises an executable software application being executed on the e-commerce server computer (*see fig 1, page 5, paragraph 0053, 0054*).

5. As per claim 12, Biddle et al teach an improved system wherein the program download site means comprises an executable software application being executed on the supplier server computer (*see fig 1, page 5, paragraph 0053, 0054*).

6. As per claim 13, Biddle et al teach an improved system wherein the licensing modules and the program modules each comprise executable software applications for execution on programmable computers, each the licensing module cooperating with one the program module to function as a whole software application (*see fig 1, page 5, paragraph 0054, 0055*).

7. As per claim 14, Biddle et al teach an improved system wherein each the distribution of one the program module is responsive to the prior execution of one the licensing module on one the customer terminal computer (*see fig 1, page 5, paragraph 0053, 0054*).

8. As per claim 15, Biddle et al teach an improved system wherein each the distribution of one the program module commences automatically in response to user input to the executed licensing module through the input means of the customer terminal computer (*see fig 1, page 5, paragraph 0053, 0054*).

9. As per claim 16, Biddle et al teach an improved system wherein the execution of the program module defines a licensed condition and an unlicensed condition, the program module executes in the licensed or unlicensed condition responsive to output from the licensing module (*fig 2, page 6 paragraph 0057*).

10. As per claim 17, Biddle et al teach an improved system wherein execution of the program module in the unlicensed condition is permitted for a pre-defined period of time, whereby expiration of the pre-defined period of time will prevent the program module from further execution (*see fig 9 and 10, page 6 paragraph 0059*).

11. As per claims 18, Biddle et al teach a method of distribution (*distribution system*) a software product to user (*user, 30*) over a computer network (*see fig 1*) comprising configuring the software product as a program module and a licensing module wherein both the program and the licensing module are required in order to operate the software product (*see paragraphs 0055*), the licensing software comprising a portion of the software product that is customized for a distributor or a group of distributors and the program module comprising a portion of the

software product that is not customized for a specific distributors, configuring the licensing module to the requirement of a distributor, storing the configured licensing module at the distributor's software distribution point so that it may be downloaded by a user and storing the program module at a location other than the distributor's software distribution point (*see paragraphs 0055, 0058, 0059, 0062, 0065, 0066, 0062*)

12. As per claim 19-21 Biddle teach a method wherein subsequent to downloading the licensing module and is certain predetermine conditions such as payment, user registration are met the user may download the program module (*see paragraphs 0100*).

13. As per claim 22, Biddle teach a method further comprising updating the software product bi modifying the program but not modifying the licensing module (*see paragraph 0078, 0087*).

14. As per claim 23-26, Biddle teach a method running the licensing module within a predetermined period of time to automatically download the program module (*see paragraphs 0100*)

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-5 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biddle et al (U.S. Patent Application Pub. No. 2002/0107809 A1) in view of Hayes et al (U.S. PG Pub No. 2001/0011341).

17. As per claim 1, Biddle teaches an improved system (*improved distribution system*, 20) for electronic data (*software*) sales and distribution (*distribution*) over wide area computer networks (*internet*, 35) (*see abstract figs 1, 2, page 2, paragraphs 0013, 0015, and 0016, page 4 paragraph 0049*), the networks comprising a network conduit (*data links 45, 50 and 55*), at least one e-commerce server computer (*distributor 25, vendor 40*) in communication (*interconnected*) with the network conduit (*see fig 1, page 4, paragraph 0049*), , and at least one customer terminal computer (*user computer, 30*) in communication (*interconnected*) with the network conduit, each the computer comprising input means, display means, processing means, storage means and means for communicating with the network conduit (*see page 4 paragraph 0050*), the system comprising e-commerce site means (*distributor 25, vendor 40*) for presenting e-commerce functions (*online transactions enabling purchase*) to each the customer in communication with the e-commerce server computer via the network conduit (*see fig 1, page 5, paragraph 0053, 0054*) (*see fig 17, page 5 paragraph 0054, 0055, page 6 paragraph 0056, 0057, 0058*) and program download site means (*distributor 25, vendor, 40*) for providing a program module (*software application*) for downloading (*downloading*) to each the customer terminal computer responsive to a user request (*see fig 1, page 5, paragraph 0054 (bottom)*).

18. Biddle fails to teach a licensing module means for giving each the customer terminal computer permission to download a program module to the customer terminal computer the

licensing module means comprising an executable software application being executed on each the customer terminal computer engaged in the improved system.

19. However, Hayes teaches licensing module means for giving each the customer terminal computer permission to download a program module to the customer terminal computer the licensing module means comprising an executable software application being executed on each the customer terminal computer engaged in the improved system (*see paragraph 0013*).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Biddle to include Hayes et al's inventive concept of a licensing module means for giving each the customer terminal computer permission to download a program module to the customer terminal computer the licensing module means comprising an executable software application being executed on each the customer terminal computer engaged in the improved system because this would have ensured greater security of the system.

21. As per claim 2, Biddle et al teach an improved system wherein the e-commerce site means comprises an executable software application being executed by the processing means of the e-commerce server computer and the program download site means comprises an executable software application being executed by a processing means in a program module server computer, the e-commerce server computer and the program module server computer being distinct from one another (*see fig 1, page 5, paragraph 0053, 0054*).

22. As per claim 3, Biddle et al teach an improved system wherein the e-commerce site means further provides each the customer terminal computer with the ability to download the licensing module means (*see fig 1, page 5, paragraph 0053, 0054*).

23. As per claim 4, Biddle et al teach an improved system further comprising a supplier terminal computer (*distributor 25*) in local area network communication with the program module server computer (*see fig 1, page 5, paragraph 0053, 0054*).

24. As per claim 5, Biddle et al teach an improved system wherein the functionality of the program module is responsive to output from the licensing module, the program module and the licensing module each comprising executable software applications, wherein output from the licensing module is input to the program module when the program module and the licensing module are executed on the processing means of a single computer (*see fig 1, page 6, paragraph 0056, 0057*).

(10) Response to Argument.

Applicants argue the prior art Biddle et al fail to teach

A licensing module as recited in claim 10.

A program module as recited in claim 18.

Storing software application

Applicants further argue that Hayes fail to teach

Downloading some desktop objects for which permission is granted.

Examiner respectfully disagrees with Applicants' characterization of the prior arts.

Biddle clearly teach an invention whereby a user is able to configure his or her desktop so as *presumably to be able to access an application on the server when, in fact, the user does not have system permission to access the application.* When the user logs onto the system, the user identifies him or herself to the server by means of a system identifier and a password. The server uses this information to built dynamically a list of applications to which the user has access permission. That list is transmitted to the users station. Biddle et al further teach a profile manager 206 on the client side allows the administrator to configure user applet preferences at both user and group levels. The administrator can create new users and group hierarchies, add users to different groups, specify applet permissions for each group and for individual users. And the administrator can configure applets in the context of an individual user or a group. The administrator can add, delete and reset passwords for users. Profile management support is transparent to the general user. The administrator can invoke the profile manager 206 in the context of any user or group. Only the administrator can change from his/her context to administer clients (users) and groups. The server will not allow a user without administrative

authority to switch context. When a request comes into the server, it will query the authenticated ID of the user trying to access this function. If the user does not possess administrative authority, (i.e., is not a member of the All Users. Administrator group), the Profile Manager Servlet 214 will reject the request. Hayes et al teach The software licensing management method includes the following exemplary steps: (1) the vendor/developer creates a software application product to be licensed; (2) the vendor/developer identifies a hardware system to act as a licensing management platform and installs the license management server software on that system; (3) using tools integrated with the licensing management software, the vendor/developer generates optionally customized instructions for wrapping license management code around the application to create a license management protected application; (4) the protected application may then be packaged and delivered to end-user licensees for subsequent installation and use; (5) when a local instance of the protected application is instantiated by the end-user licensee management client, the management client requests authorization from the license management server to provide appropriate access to the wrapped application; and (6) the vendor/developer installs optionally customized database views for order fulfillment and field support systems to receive product orders and/or to manage sales.

Furthermore, Examiner noticed that Applicant use functional language (i.e. an ecommerce site for) in the claim. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. “As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(affirming the Board’s claim construction of “further including that said wall may be smooth, corrugated, or profiled with

increased dimensional proportions as pipe size is increased” since “this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form ‘may.’”). See also *e.g.* MPEP §2106 II C: which states, “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”

For sake of clarity, a map chart of the broadest claim is presented.

Broadest claim 10

Claim limitations	<i>Prior art (Biddle)</i>
An improved system for software distribution over wide area computer networks, said networks comprising a network conduit, at least one e-commerce server computer in communication with said network conduit, at least one customer terminal computer in communication with said network conduit, and at least one supplier server computer in communication with said network conduit, each said computer comprising at least one programmable computer comprising input device, display device, processing device, storage device and device for communicating with said network conduit	A global location for third party software development companies to distribute software tools is also disclosed (<i>pp 0016</i>).
an e-commerce site for distributing licensing modules to each said customer terminal computer via said network conduit	license management and access control service 72 (licensing server service). This is installed, in one preferred exemplary embodiment, as a system service on the licensing server for controlling access to the database 49 by the vendor 40 using an access tool 67, 68, 69 or 71 and by the user 30 running a protected application. The table in FIG. 4 shows exemplary program features and various views available to the user 30 when using access tool 67, 68, 69 or 71. The service 72, in one exemplary

	aspect, listens for incoming requests on a specified port, determines how many license requests may be processed at one time and the length of time that a license request will run before being terminated; and processes license requests (<i>pp 0059</i>).
a program download site for distributing program modules to each said customer terminal computer via said network conduit	the distributor 25 sends a "toolkit" to the vendor (step 106). Vendor 40 uses the toolkit to prepare the vendor software by making modifications to the software applications (step 110). Vendor 40 then compiles the software application with the new modifications and additions and sends the compiled version of the software to the distributor 25. The distributor 25 wraps the software and sends it back to the vendor 40 (step 114). The vendor 40 then adds the wrapped software application to an install program (step 118) and sends it back to the distributor 25. The distributor 25 then adds the software application to the electronic store (step 122) to allow users 30 to download the software application to a user computer (step 126). After downloading and installing the application, user 30 has the option of obtaining a license for the application, for example, either in the form of a free trial period, by purchasing a subscription, or purchasing a long-term license (step 128). After obtaining a license, user 30 can then run the application (<i>pp 0054</i>).
wherein said licensing modules and said program modules each comprise executable software applications for execution on programmable computers, one said licensing module cooperating with one said program module to function as a whole software application, said distribution of one said program module is responsive to the prior execution of one said licensing module on one said customer terminal computer	The software code provided in the toolkit may also include licensing application programming interface (API) calls which are substituted during the wrapping process with a final version of the licensing API code provided by the distributor 25. This code may, for example, run security checks when the vendor software is running on the user computer 30 and contributes to the overall security that the distributor provides for the vendor software application. In accordance with one embodiment of the present invention, the software code, provided by the distributor and integrated by the vendor 40 into the software application, allows the distributor 25 to add appropriate anti-piracy and tampering checks during the wrapping process described herein. This, <i>inter alia</i> , reduces the vendor's responsibility for spending additional time and/or

	resources to engineer the appropriate security measures in each software application. In addition, the present invention reduces the vendor involvement in security violation issues and transfers the responsibility to the distributor or to the security technology provider (<i>pp 0073</i>)
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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained,

Respectfully submitted
John M Winter
/John M Winter/

Examiner

Art Unit 3685

JMW
October 13, 2008

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